

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed April 5, 2005. At the time of the Office Action, Claims 36-46 were pending in the Application. Applicant amends Independent Claim 36 without prejudice or disclaimer. The amendment to the claim is not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendment is not related to patentability issues and only further clarifies subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 and 103 Rejections

The Examiner rejects Claims 36-46 under 35 U.S.C. §102(e) as being anticipated by copending application No. 09/608,657. The Examiner rejects Claims 36-43 and 46 under 35 U.S.C. §102(a) as being anticipated by European Patent Application EP 920153 A2 (hereinafter "*Shiragaki*"). The Examiner rejects Claim 44 under 35 U.S.C. §103(a) as being unpatentable over *Shiragaki* as applied to the claims above, and further in view of U.S. Patent No. 5,647,035 issued to Cadeddu et al. (hereinafter "*Cadeddu*"). The Examiner rejects Claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Shiragaki* as applied to the claims above, and further in view of Ramaswami et al. (i.e. an article entitled "Optical Networks: A Practical Perspective," hereinafter "*Ramaswami*"). These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142-43.) It is respectfully submitted that these claims are patentable over the art of record based on, at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, Independent Claim 1 recites a configuration of transponders that are operable to facilitate the operations of the system. Neither *Cadeddu*, nor *Karasan*, nor *Shiragaki* offer such an arrangement. Moreover, the structure of *Cadeddu*, *Karasan*, and *Shiragaki* are incapable of performing the operations, as identified by Independent Claim 1. Note that because

the reconfiguration takes places at the channel level, each node does not have to be provided with switching equipment to perform protection on all the network channels. (See Original Specification for support: pages 5-6.) Moreover, the interaction between the transponders and the optical receiver is disparate from any of the teachings of the cited references. For at least these reasons, Independent Claim 1 is patentable over these references.

Applicant also notes that any combination of *Shiragaki*, *Karasan*, and *Cadeddu* and some other reference that may disclose parts of such a configuration and would be inappropriate in the context of the §103 rejection. This is because there is no evidence to suggest that *Shiragaki*, *Karasan*, and/or *Cadeddu* would be capable of successfully operating together in a fashion outlined by the pending subject matter. In addition, there is no evidence to even support that any of these references could provide the transponder configuration identified by pending claims. Moreover, there is no teaching, disclosure, or suggestion to make any such combinations proffered by the Examiner. These essential facts would vitiate another required prong of obviousness and, therefore, render the pending claims allowable based on this single reason.

Thus, Independent Claim 1 is allowable over *Cadeddu*, *Karasan*, and *Shiragaki* for the reasons tendered above. In addition, the dependent claims associated with this Independent Claim are also allowable for analogous reasons. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

Double Patenting and Provisional Rejections

The Examiner provisionally previously rejected Claims 36-39, 41-44, and 46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 09/608,657 in view of *Cadeddu*. The Examiner also provisionally previously rejected Claim 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 09/608,657 in view of *Cadeddu* as applied to Claim 36, and further in view of *Ramaswami*.

Applicant stands prepared to submit a Terminal Disclaimer in order to overcome the nonstatutory double patenting rejection and to advance the prosecution of this case. Any filing of the Terminal Disclaimer should not be construed as an agreement with or an acquiescence to the propriety thereof. Applicant reserves the right to comment on the appropriateness of the Terminal Disclaimer at a future time, should Applicant deem it appropriate to do so.

CONCLUSION

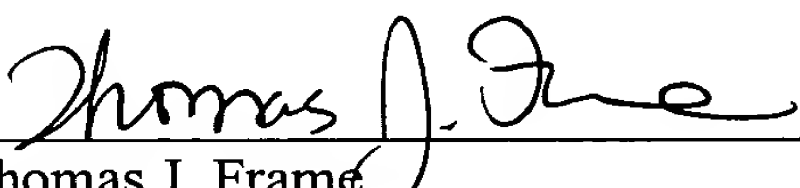
Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,

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Date: May 2nd, 2005

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